

REMARKS

This is in response to the Office Action mailed on November 4, 2004, and the references cited therewith.

None of the claims are amended and claims 1-2 are canceled; as a result, claims 3-14 are now pending in this application.

Information Disclosure Statement

The Examiner has noted that the Information Disclosure Statement filed March 24, 2004 has not been considered in its entirety because the cited foreign references appeared not to have been provided. Although it is Applicant's understanding that copies of foreign references cited in the parent application need not be provided in the present case, in order to advance prosecution, copies of the four cited foreign references are provided herewith.

§102 Rejection of the Claims

Claim 1 was rejected under 35 USC § 102(b) as being anticipated by Hunter et al. (US 6,071,030). Claim 1 has been cancelled without prejudice or disclaimer.

§103 Rejection of the Claims

Claims 2, 3 and 7-12 were rejected under 35 USC § 103(a) as being unpatentable over Hunter et al. (US 6,071,030) in view of Policht (US 5,040,216). Claim 2 has been canceled without prejudice or disclaimer.

Claims 3 and 7-9

Applicant traverses the rejection of claim 3 since there is no suggestion in the art to combine the references as suggested. Moreover, even if combined, the combination does not include each limitation recited in the claim.

The reference (or references when combined) must teach or suggest all the claim elements. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Claim 3 recites: providing a blank photo sheet, and sending the blank photo sheet and attached mounting strip through a printer to print an image on the sheet. In contrast, neither reference discusses such subject matter. As admitted by Office Action, Hunter does not teach mounting photographic printer paper to an album. Moreover, Policht also does not include such subject matter. In contrast, Policht discusses mounting pre-developed photographic prints to a binder. Accordingly, even if combined, the combination does not include a blank photo sheet or sending the blank photo sheet and its attached mounting strip through a printer. As noted, Policht discusses a developed photographic print. Such prints are finished complete products and are not suitable for going through a printer.

Moreover, the cited references teach away from applicant's claimed invention. A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path the applicant took. *In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994).

Here, Hunter describes index divider sheets that are used for three-ring notebooks. One skilled in the art would not be motivated to substitute photo quality paper for such divider sheets. Photo quality paper would not work well as divider sheets, which require a heavy, stiff paper, such as cardstock. (Hunter, col. 6, lines 61-62). Moreover, substituting the developed photographic prints of Policht for the cardstock of the Hunter index dividers is not a logical combination since photographic prints would not work well as index dividers.

Claims 7-9 include each limitation of their parent claim and are therefore also not obvious in view of the cited references. Reconsideration and allowance is respectfully requested.

Claims 10-12

Applicant traverses the rejection of claim 10 since there is no suggestion in the art to combine the references as suggested. Moreover, even if combined, the combination does not include each limitation recited in the claim.

Claim 10 recites: providing a blank photo-printable sheet having a hinge strip mounted along an edge of the sheet, and sending the blank photo-printable sheet with the hinge strip

through a desktop printer to print a photographic image upon the sheet. Again, as discussed above, neither reference discusses a blank photo-printable sheet or printing a photographic image upon the sheet. Hunter discusses cardstock index dividers and Policht discusses developed photo prints. Accordingly, even if combined, the combination does not include printing a photographic image upon a blank photo-printable sheet having a hinge strip mounted thereto.

Moreover, the cited references teach away from applicant's claimed invention. Again, Hunter describes index dividers that are made from cardstock. One skilled in the art would not be motivated to substitute developed photos for the cardstock of such index dividers.

Claims 11-12 include each limitation of their parent claim and are therefore also not obvious in view of the cited references. Reconsideration and allowance is respectfully requested.

Claims 4, 6, 13 and 14 were rejected under 35 USC § 103(a) as being unpatentable over Hunter et al. (US 6,071,030) in view of Policht (US 5,040,216) as applied to claims 2, 3 and 7-12 above, and further in view of Tyler (US 4,207,366).

Claims 4, 6, and 13-14 include each limitation of their parent claims and are not obvious for the reasons given above. Moreover, Applicant traverses the present rejection. Applicant believes claims 4, 6 and 13-14 are not obvious in view of the present references since there is no suggestion to combine the references as suggested.

As noted, Hunter teaches an index divider. The secondary reference, Tyler, discusses an art paper used for watercolors. This teaches away from being used in a printer. Moreover, any combination of the Tyler paper substituted for the Hunter cardstock would not work well as an index divider since these are different papers for completely different uses.

Moreover, regarding claim 14, Applicant does not believe that the merely noting that Tyler teaches acid free paper is enough to find a motivation for one to provide an acid free hinge. One does not necessarily lead to the other without a motivation in the art. Reconsideration and allowance is respectfully requested.

Claim 5 was rejected under 35 USC § 103(a) as being unpatentable over Hunter et al. (US 6,071,030) in view of Policht (US 5,040,216) as applied to claims 2, 3 and 7-12 above, and further in view of Singh et al. (US 6,332,953).

Claim 5 includes each limitation of its parent claim and is not obvious for the reasons given above. Moreover, Applicant traverses the present rejection. Applicant believes claim 5 is not obvious in view of the present references since there is no suggestion to combine the references as suggested. As noted, Hunter teaches a cardstock index divider. The secondary reference, Singh, discusses an envelope paper. A combination of the Singh paper would not work well as an index divider and thus the references teach away from being combined. Reconsideration and allowance is respectfully requested.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 359-3267 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

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1/4/05

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 4 day of January, 2005.

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